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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,165	09/04/2003	Deryck J. Williams	12557-021001	5413
26161	7590	01/10/2006	EXAMINER	
FISH & RICHARDSON PC			PAK, JOHN D	
P.O. BOX 1022			ART UNIT	
MINNEAPOLIS, MN 55440-1022			PAPER NUMBER	

1616

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,165

Applicant(s)

WILLIAMS ET AL.

Examiner

JOHN PAK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 75-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/6/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Claims 1-84 are pending in this application.

Applicant's election without traverse of the invention of Group I in the reply filed on 9/30/2005 is acknowledged. Accordingly, claims 75-84, and non-elected subject matter in claims 1-74 (see the previous Office action of 8/29/2005), are withdrawn from further consideration. Claims 1-74, *to the extent* that they read on the first formula in claim 1 (applicable to other claims, claim 1 noted only for the formula), will presently be examined.

It is noted that "substituant" is a misspelling of "substituent." Correction is suggested throughout the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 13-16, 18-21, 25, 31-32, 43-46, 48-51, 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner et al. (US 4,251,255).

Wagner et al. explicitly disclose supplying plants and plant habitat with a nutrient, azulmic acid-based formulation that contains a surfactant with liquid carrier/diluent (claim 3) and ricinoleic acid (claim 16). The added ricinoleic acid functions as the acid addition salt (claims 1, 9). See also claim 28.

Even though nematicidal activity is not expressly disclosed, such effect would necessarily have been present in Wagner's application of the same exact ricinoleic acid to plants and plant habitat, i.e. soil. The claims are thereby anticipated.

Claims 1-2, 9-16, 18-21, 23, 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmitt et al. (US 5,389,300).

Schmitt et al. explicitly disclose the combination of, inter alia, sodium ricinoleate, water, butanol and sodium dodecylbenzenesulfonate, which is a surfactant (see e.g., Examples 1, 4-6 on columns 5-6; claims 1 and 7). Fungicidally effective o-phenylphenol is included (id.). Mineral oils are taught for solvent use (column 3, lines 6-7).

Although Schmitt et al. do not specifically disclose nematicidal activity, it is the Examiner's position that such activity would necessarily have been present in Schmitt's composition because the same exact ricinoleic acid salt (which meets applicant's elected subject matter formula) is formulated with the same surfactant and the same excipients. The fact that there is water with Schmitt's sodium ricinoleate means that some of the salts must necessarily equilibrate to the acidic form. Schmitt's butanol is within the scope of permeation enhancer. The claims are thereby anticipated.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al. in view of Farm Chemicals Handbook '98.

Schmitt et al. disclose the combination of, inter alia, sodium ricinoleate, water, butanol and sodium dodecylbenzenesulfonate, which is a surfactant (see e.g., Examples 1, 4-6 on columns 5-6; claims 1 and 7). Other solvent or emulsifier ingredients are taught (see parts (c) and (d) in claim 1). Mineral oils are taught for solvent use (column 3, lines 6-7). Various emulsifiers, including non-ionic surfactants such as alkyl polyglycol ethers, alkylaryl polyglycol ethers, and anionic surfactants such as alkali metal salts of ricinoleic acid are taught, as well as mixtures of several emulsifiers (column 3, lines 17-26). Fungicides, insecticides, or other active compounds can be added, such as myriad structurally divergent pesticidal agents (see from column 3, line 26 to column 4, line 48).

Farm Chemicals Handbook '98 discloses oxamyl to be a known insecticide, nematocide and acaricide (page C290, left column).

The difference between the claimed invention and the cited references is that the references do not explicitly disclose the specific combination of the ingredients, as claimed.

Claim 22 requires specific commercial surfactants. For example, Makon 10 is an ethoxylated alkylphenol, Brij 35, Brij 97 and Tergitol TMN 6 are ethoxylated alcohols, Dowfax 3B2 is a diphenyl sulfonate. Given Schmitt's broad disclosure of suitability of various nonionic and anionic surfactants, one having ordinary skill in the art would have been motivated to utilize other commercially available surface active agents to arrive at the claimed composition.

Claim 27 requires the further use of an additional active agent such as oxamyl. The cited secondary reference clearly teaches that oxamyl has well known, broad pesticidal properties. Schmitt et al. teach the incorporation of other pesticidal agents, and as a result, one having ordinary skill in the art would have been motivated to utilize such a versatile and active pesticide such as oxamyl in order to provide further protection against invertebrate pests.

Claims 28-29 require an antioxidant such as BHA and BHT. Such ingredients are notoriously well known antioxidants, and their use would have been obvious from the knowledge of fatty acid chemistry. The unsaturated carbon chain in the fatty acid moiety is subject to oxidation, so use of known antioxidants would have been fairly suggested when using ricinoleic acid salts.

Claim 30 requires the use of at least two different compounds of the elected formula. Schmitt et al. teach the use of mixtures of ricinoleic acids (column 3, lines 22-24), so such two different compounds are suggested.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited reference.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-12, 15-31, 33-42, 45-74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of U.S.

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Patent No. 6,887,900. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

Patented claims 1-47 are directed to substantially the same subject matter as applicant's claims, with minor overlap in scope in substituent recitations. For example, the esters of the patented claims are all readable on instant claims. The esters in the patented claims have the same activity and said esters are formulated with the same excipients. Therefore, one of ordinary skill in the art would have recognized the instant invention as an obvious variation of the invention patented in claims 1-47 of U.S. Patent No. 6,887,900, because use of known commercial surfactants or known additional active insecticide or nematocide would have been obvious for the benefit of providing improved formulation or pesticidal properties

Claims 1, 3-12, 15-31, 33-42, 45-74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21, 24-55, 61-65 of U.S. Patent No. 6,903,052 in view of Farm Chemicals Handbook '98. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

Patented claims are directed to substantially the same subject matter as applicant's claims, with minor overlap in scope in substituent recitations. For example, the esters of the patented claims are all readable on instant claims. The esters in the

patented claims have the same activity and said esters are formulated with the same excipients.

Farm Chemicals Handbook '98 discloses oxamyl to be a known insecticide, nematocide and acaricide (page C290, left column). This secondary reference is cited to establish the fact that the additional active agent of applicant's claim 27 is known for the use for which it is being claimed.

Therefore, one of ordinary skill in the art would have recognized the instant invention as an obvious variation of the invention patented in claims 1-21, 24-55, 61-65 of U.S. Patent No. 6,903,052, because use of known commercial surfactants or known additional active insecticide or nematocide would have been obvious for the benefit of providing improved formulation or pesticidal properties.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

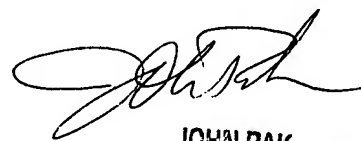
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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